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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,823	03/03/2000	JUNICHI SHIMADA	506.38266X00	3013

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EXAMINER

SPIVACK, PHYLLIS G

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 09/04/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/486,823

Applicant(s)
Shimada et al.

Examiner
Phyllis G. Spivack

Art Unit
1614



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 7, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-17 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1614

Applicants' Amendment filed August 7, 2002, Paper No. 16, is acknowledged and has been entered. The claims under consideration remain 6-17.

The finality of the last Office Action is withdrawn. An indication of allowable subject matter in the last Office Action is withdrawn.

Following an amendment to claim 6 in which Parkinson's disease is excluded from among those conditions characterized as neurodegenerative disorders, the rejection of record of claims 6-9 under 35 U.S.C. 102(b) as being anticipated by Suzuki et al., U.S. Patent No. 5,484,920, is withdrawn.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baraldi et al.,

Current Medicinal Chemistry.

Baraldi teaches the administration of various compounds of instant formula I in the treatment of cerebral ischemia or neurodegenerative disorders and to improve learning and enhance cognition. See Table 3, page 711. On page 13 of the specification, brain ischemia is listed among those disorders for which the present neurodegenerative methods are directed. Parkinson's disease, which is excluded from the present claims, is the only specifically recited

Art Unit: 1614

neurodegenerative disorder disclosed by Baraldi. However, one skilled in the neurology art would have been motivated to administer 8-styrylxanthines, as disclosed by Baraldi, to treat other neurodegenerative disorders and Alzheimer's disease. Such would have been obvious in the absence of evidence to the contrary because Alzheimer's disease is characterized by a decrease in cognition. One skilled in the art would have been motivated to administer these xanthine derivatives to treat neurodegeneration based on their demonstrated potential for both anatomical and function neuroprotection. It would have been reasonable to expect the specific adenosine receptor antagonists, as disclosed by Baraldi in Table 3, would have been effective in inhibiting neurodegeneration and treating neurodegenerative disorders, other than Parkinson's disease, in view of Baraldi's teaching.

No claim is allowed.

Any inquiry concerning this communication should be directed to Phyllis Spivack at telephone number 703-308-4703.

August 30, 2002

Phyllis Spivack

**PHYLLIS SPIVACK
PRIMARY EXAMINER**